

## REMARKS

This amendment responds to the office action mailed June 23, 2004. In the office action the Examiner:

- rejected claims 14, 29 and 38 under 35 U.S.C. 102(b) as anticipated by Cooke et al. (US 3,659,205);
- rejected claims 14, 29 and 38 under 35 U.S.C. 102(b) as anticipated by OI (JP 59-4204);
- rejected claims 14, 29 and 38 under 35 U.S.C. 102(b) as anticipated by Yamada et al. (US 5,018,000);
- rejected claims 14-15, 17, 20-21, 29, 31, 33 and 38-40 under 35 U.S.C. 102(b) as anticipated by Buck et al. (US 4,310,809);
- rejected claims 14, 17, 20-21, 25, 29, 33 and 38 under 35 U.S.C. 102(b) as anticipated by Schwent et al. (US 5,363,071);
- rejected claims 14, 17, 20-21, 23-24, 27, 29, 33, 35-38 and 43 under 35 U.S.C. 102(b) as anticipated by Maruhashi (US 5,384,558);
- rejected claims 16, 18-19, 22, 35 and 42-43 under 35 U.S.C. 103(a) as unpatentable over Maruhashi (US 5,384,558) in view of Wark et al. (US 5,982,018);
- rejected claims 25-28, 30, 32 and 44-45 under 35 U.S.C. 103(a) as unpatentable over Maruhashi (US 5,384,558) in view of Ammon et al. (US 3,868,162); and
- rejected claim 41 under 35 U.S.C. 103(a) as unpatentable over Maruhashi et al. (US 5,384,558) in view of Geiszler (US 3,359,510).

After entry of this amendment, the pending claims are: claims 46-67.

### Overview of Changes to Claims

To clarify the claimed invention in the present application, claims 14-45 have been cancelled and new claims 46-67 have been added. Claims 46-63 and 65-66 find support in the previously presented claims. The word “removably” in claim 46 finds support at col. 6, lines 3-4 in the parent patent (US 6,266,730) for this application. Claim 64 finds support in Fig. 4. Claim 67 finds support at col. 6, lines 6-7 in the parent patent (US 6,266,730) for this application. The new claims, therefore, do not constitute new matter.

It is noted that the changes to the claims have been made to advance prosecution, and do not constitute an admission that the Examiner’s rejections of those claims were properly based on the prior art of record. The Application reserves the right to resubmit those claims, or similar claims, in one or more continuation applications.

The new claims are novel and unobvious over the prior art of record. Referring to the limitations of independent claim 46, Cooke et al. does not address a memory module. Cooke does not have “one capacitor electrode connected to the first connector at a junction where the contact connects to the first conductive trace” (see the location of capacitor (13) in Fig. 1 of Cooke et al.). In addition, the Balun circuit in Cooke et al. is not a connector “for removably connecting the first circuit board to a second circuit board.”

OI does not address a memory module. OI does not have a connector “for removably connecting the first circuit board to a second circuit board.” and does not have “one capacitor electrode connected to the first connector at a junction where the contact connects to the first conductive trace.”

Yamada et al. does not address a memory module. Yamada et al. does not have a connector “for removably connecting the first circuit board to a second circuit board.” and does not have “one capacitor electrode connected to the first connector at a junction where the contact connects to the first conductive trace.”

Buck et al. does not address a memory module. Buck et al. does not have a connector “for removably connecting the first circuit board to a second circuit board.” and does not have “one capacitor electrode connected to the first connector at a junction where the contact connects to the first conductive trace.” The capacitor 62 in Fig. 2 in Buck et al. is not at such a junction and, in fact, there is no removable connector.

Scwent et al. does not address a memory module. Schwent et al. does not have a connector “for removably connecting the first circuit board to a second circuit board.” and does not have “one capacitor electrode connected to the first connector at a junction where the contact connects to the first conductive trace.” The capacitor 706 in Fig. 7 in Schwent et al. is not at such a junction and, in fact, there is no removable connector for forming a removable connection.

Maruhashi does not address a memory module. Maruhashi does not have a connector “for removably connecting the first circuit board to a second circuit board.” and does not have “one capacitor electrode connected to the first connector at a junction where the contact connects to the first conductive trace.” The capacitor 2 in Fig. 1A in Maruhashi is not at such a junction and, in fact, the biasing point 4 is not a removable connector (i.e., a connector for forming a removable connection).

In light of the absence of claimed limitations in Maruhashi, the combination of Maruhashi and Wark et al. does not achieve the limitations of the claimed invention. In addition, there is no motivation for combining these references to achieve the limitations of the claimed invention. As a consequence, the combination is not *prima facie* obvious.

In light of the absence of claimed limitations in Maruhashi, the combination of Maruhashi and Ammon et al. does not achieve the limitations of the claimed invention. In addition, there is no motivation for combining these references to achieve the limitations of the claimed invention. As a consequence, the combination is not *prima facie* obvious.

In light of the absence of claimed limitations in Maruhashi, the combination of Maruhashi and Greiszler does not achieve the limitations of the claimed invention. In addition, there is no motivation for combining these references to achieve the limitations of the claimed invention. As a consequence, the combination is not *prima facie* obvious.

The Applicants submit, therefore, that the present application is patentable over the prior art of record. Reconsideration of the present application is requested.

#### CONCLUSION

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney if a telephone call could help resolve any remaining items.

Date

: September 15, 2004

Respectfully submitted,



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